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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,983	06/14/2001	Isaac K. Elliott	VON96046C1	6036
25537	7590	11/08/2005	EXAMINER	
MCI, INC 1133 19TH STREET NW 4TH FLOOR WASHINGTON, DC 20036				PHAN, MAN U
		ART UNIT		PAPER NUMBER
		2665		

DATE MAILED: 11/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

JK

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/879,983	ELLIOTT ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Man Phan	2665	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 15 August 2005.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-6 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 1-11 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

***Response to Amendment and Argument***

1. This communication is in response to applicant's 08/15/2005 Amendment in the application of Elliott et al. for a "System and method for providing requested quality of service in a hybrid network" filed 06/14/2001. This application is a continuation of US Application 08/751,917 filed November 18, 1996 is now US Patent# 6,335,927. The proposed amendment to the claims and response have been entered and made of record. Claim 1 has been amended, and new claims 7-11 have been added. Claims 1-11 are pending in the present application.
  
2. The amended paragraphs in specification correct the status of the patent applications referenced. Therefore, examiner has withdrawn the Objections of record to the specification. The objection of record with respect to claim 1 is hereby removed based on applicant's amendment.

***Remarks***

3. Applicant's amendment to the pending claims have been considered but are moot in view of the new ground(s) of rejection, and will be examined as discussed below. Furthermore, the terminal disclaimer filed on 08/15/2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 6,335,927 filed 11/18/1996 and issued 01/01/2002 has been reviewed and is accepted. The terminal disclaimer has been recorded. Rejections based on the newly amendment follows.

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-6 drawn to the path finding or routing. Subject matter including an apparatus or a technique for locating a path through a switching network from a source to a destination. Wherein the switching network has both (a) a switch which establishes a path between a source and destination with the path being held for the duration of the communication, and (b) a switch which routes information based on an address associated with the information data in a channel which is only occupied for a duration of the time required to transmit the information data and the associated address. Classified in **class 370, subclass 352.**

II. Claims 7-11 drawn to the channel assignment techniques. Subject matter having details of a technique for allocating usage of a communication channel or channels to subscriber terminals. Subject matter having a device for interconnecting two or more networks at a media-access level of a data-link layer. Classified in **class 370, subclass 401.**

5. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II which has separate utility such as having details wherein allocating a communication channel to a user or subscriber for transmission of

information, which does not include the particular listed of the invention I, such as method for a bridge or gateway between networks. See MPEP ' 806.05(d).

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37.CFR 1.143). Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

8. For advance prosecution in the application, a provisional election was made to prosecute the invention of the original claims 1-6 (group I). Claims 7-11 (group II) are withdrawn from further consideration by the Examiner, 37 C.F.R. ' 1.142(b), as being drawn to a non-elected invention. Rejections of the claims 1-6 as follows:

***Double Patenting***

9. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain : patent therefor ..." (Emphasis added). Thus, the term "same invention" in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1-6 of the present application Serial No. 09/879,983 (hereinafter Application '983) rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,335,927 (hereinafter patent '927) since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The claims are identical and they are not patentably distinct from each other because the subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent, since the patent and the application are claiming common subject matter. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are equivalent in scope and embodiment. The language of the two claims is substantially identical and is equivalent in functioning. All of the structural elements of the patent claims are present in the pending claims, defined with either identical or equivalent language. Additionally, the functional language, scope and embodiment reflects identical operation, purpose, application, and environment.

With respect to the specific limitations, claim 1 of patent '927 is equivalent to the pending claims 1-2 of Application '983. The pending claims 3-6 of Application '983 are equivalent to the claims 2-5 of patent '927 respectively.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA). Also note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art.

### *Conclusion*

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Eastep et al. (US#6,731,625) discloses a system, method and article of manufacture for a call back architecture in a hybrid network with support for internet telephony.

Bowman-Amuah (US#6,426,948) discloses a video conferencing fault management in a hybrid network.

Bowman-Amuah (US#6,611,867) discloses a system, method and article of manufacture implementing a hybrid network.

Bowman-Amuah (US#6,556,659) discloses a service level management in a hybrid network architecture.

Bowman-Amuah (US#6,95,697) discloses a system, method and article of manufacture for providing a customer interface in a hybrid network.

Erimli et al. (US#6,745,246) discloses an apparatus and method in a network switch for modifying a bandwidth request between a requestor and a router.

Baxley et al. (US#6,879,565) discloses a large scale, fault tolerant audio conferencing over a hybrid network.

Baxley et al. (US#6,657,975) discloses a large scale, fault tolerant audio conferencing over a hybrid network.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION THIS ACTION IS MADE FINAL**. See MPEP ' 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Phan whose telephone number is (571) 272-3149. The examiner can

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normally be reached on Mon - Fri from 6:00 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu, can be reached on (571) 272-3155. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2600.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at toll free 1-866-217-9197.

Mphan

Oct. 27, 2005

*Man U. Phan*  
MAN U. PHAN  
PRIMARY EXAMINER